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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,043	02/19/2002	Vladimir Gartstein	8431M	4983

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THE PROCTER & GAMBLE COMPANY  
INTELLECTUAL PROPERTY DIVISION  
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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 07/08/2004

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GRC JP 3700

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/078,043  
Filing Date: February 19, 2002  
Appellant(s): GARTSTEIN ET AL.

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Jay A. Krebs  
For Appellant

**EXAMINER'S ANSWER**

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This is in response to the appeal brief filed June 7, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. There are no known related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-13 stand or fall together as indicated by appellant.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(9) Prior Art of Record**

5,720,772	Eckhouse	2-1998
5,344,433	Talmore	9-1994

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-13 are rejected under 35 U.S.C. 102(b). This rejection is set forth in a prior Office Action, mailed on December 30, 2003.

Claim 10 is rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on December 30, 2003.

**(11) Response to Argument**

Applicant argues that the recitation in claim 1 that the apparatus "is adapted for placement proximate to the *in-vivo* location of said pathogen, wherein said *in-vivo* location of said pathogen is a plant or parts thereof" does add a structural limitation to the claim. The examiner had previously indicated that the quoted limitation is merely a recitation of intended use and is no way a structural limitation. While the examiner agrees that functional limitations must be evaluated and considered for what it fairly conveys to a person of ordinary skill in the art as suggested in MPEP 2173.05(g), there is nothing in the quoted limitation which implies any structure beyond a delivery member which may be located near a plant. The examiner maintains that the Eckhouse delivery member, which is located adjacent skin, may inherently be located adjacent a plant. In particular, column 8, lines 46-55 of the Eckhouse patent disclose that the treatment

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device may be comprised of a lightweight delivery unit held in the desired location by the physician, and a separate power unit connected to the hand-held unit by a cable. Such a hand-held unit is clearly capable of being located adjacent skin tissue, an ear (including the tympanic membrane) or a plant. As such, the examiner maintains that the above quoted limitation does not add any appreciable structural limitation beyond that which is disclosed by any reasonably sized light delivery device. See also *In re Schreiber* (44 USPQ2d, 1429 (CAFC 1997)) which addresses functional limitations and the weight they are afforded in apparatus claims. Applicant has failed to establish why the Eckhouse device is structurally incapable of being placed proximate a plant or parts thereof.

Similarly, applicant asserts that the functional language of claim 11 is a structural limitation and that the Eckhouse reference is not inherently capable of being located in proximity to the tympanic membrane. Again, the examiner maintains that the handheld probe of Eckhouse, which is placed at various locations on the skin to treat reasonably small areas, is inherently capable of being located in proximity to a patient's ear (i.e. in proximity to a tympanic membrane). Applicant's claims fail to set forth any distinguishing features or elements which would require the device to be located at a position (e.g. within the inner ear) not reachable by any well-known hand held probe such as taught by Eckhouse.

Appellant continues to argue in page 6 of the Appeal Brief that Eckhouse teaches the use of electromagnetic radiation in the treatment of skin disorders primarily, and there is no evidence of treating acute otitis media or being proximate to a tympanic

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membrane. The examiner agrees with this statement but continues to assert that such an argument has no bearing on the claim language of claim 11 since all the structural features are expressly and inherently present in the Eckhouse device. The Eckhouse device includes a light source which provides the exact same wavelength and energy ranges for treating tissue. As addressed previously, the Eckhouse hand held probe is inherently capable of being located adjacent an ear and, therefore, in proximity to a tympanic membrane. Hence, the Eckhouse reference anticipates the claim language of claim 11. Again, applicant has not established why the Eckhouse device would be incapable of being located in proximity of a tympanic membrane of an animal.

It is noted that claim 10, which is a method claim, is rejected under both 35 USC 102 as being anticipated by Eckhouse, and under 35 USC 103 as being obvious over Eckhouse in view of the teaching of Talmore .

Concerning the 35 USC 102 rejection, the examiner maintains that use of the Eckhouse device to treat skin tissue would inherently provide for the meaningful suppression of the growth potential of a pathogen since the Eckhouse device provides the exact same wavelength and energy fluence. It is noted that claim 10 does not recite the specific step of treating tissue in the tympanic membrane. Rather, claim 10 merely incorporates the structure of claim 11 which recites an apparatus which is "adapted for placement proximate to said tympanic membrane of said animal". The examiner maintains, as asserted previously, that the Eckhouse device is inherently capable of such a use given that there is a hand-held delivery member for treating small tissue

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sites. Applicant has not specifically addressed the rejection of claim 10 based on 35 USC 102.

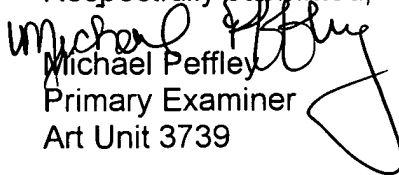
With regard to the 35 USC 103 rejection of claim 10 based on the Eckhouse patent in view of the Talmore teaching, applicant contends that the examiner failed to provide a *prima facie* case of obviousness. In particular, applicant asserts that claim 10 depends from claim 11 and therefore recites the structural limitations of claim 10. Again, applicant contends that the Talmore teaching does not suggest that the apparatus is "adapted for placement proximate to said tympanic membrane of said animal". And again, the examiner disagrees. Claim 10 contains no explicit step of locating the device near tympanic tissue. The examiner maintains that both the Eckhouse delivery member and the Talmore delivery member are capable of being placed near an ear, and hence in proximity to a tympanic membrane. The basis of using the Talmore teaching in the 35 USC 103 rejection was not to address the issue of where the Eckhouse device is "adapted" to be placed. Rather, Talmore was cited as a teaching of specifically treating skin pathogens with light energy. Eckhouse provides a device for treating skin with the same wavelength and energy fluence as set forth in applicant's invention, and the examiner maintains that use of the device would inherently treat any pathogens located on the tissue. However, the examiner has backed up this position with the Talmore reference which discloses an analogous skin treatment system and specifically addresses the treatment of pathogens located on skin tissue with the electromagnetic energy. Hence, the examiner maintains that one of ordinary skill in the art would have recognized that the Eckhouse device may be used to

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suppress pathogen growth, particularly since it provides the same electromagnetic energy requirements and further since Talmore teaches that the use of such electromagnetic devices are useful to treat skin pathogens.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Michael Peffley  
Primary Examiner  
Art Unit 3739


mp  
July 6, 2004

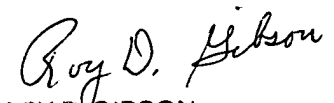
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